Oral Hearing: October 23, 2001
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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Cremieux

Serial No. 75/465,247

William H. Holt of Law Office of William H. Holt for Daniel Cremieux.

Sue Carruthers and Jeremy Klaus, Trademark Examining Attorneys, Law Office 108 (David Shallant, Managing Attorney).

Before Seeherman, Hohein and Walters, Administrative Trademark Judges.

Opinion by Hohein, Administrative Trademark Judge:

Daniel Cremieux has filed an application to register

the mark "DCS DANIEL CREMIEUX SPORT" and design, as shown below,

for "clothing, namely, suits, jackets, lumber-jackets, shirts, tracksuits, shorts, pullovers, sweat shirts, coats, rain-coats, pants, one-piece suits, tuxedos, bermuda shorts, sweaters, vests, short-sleeved shirts, t-shirts, polo shirts, ties, bow ties, belts, gloves, socks, housecoats, bathrobes, pajamas, scarves, foulards; underwear; footwear except orthopedic, diving, and athletic shoes; [and] headwear."[1]

Registration has been finally refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to his goods, so resembles the mark "DCS," which is registered for "athletic shoes,"[2] as to be likely to cause confusion, mistake or deception.

Applicant has appealed. Briefs have been filed and an oral hearing was held.[3] We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the facts in evidence which are relevant to the factors bearing on the issue of whether there is a

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[1] Ser. No. 75/465,247, filed on April 9, 1998, which is based upon a bona fide intention to use the mark as well as ownership of French Reg. No. 97/698,643, dated October 9, 1997, for such mark. The lining in the mark is for the colors blue, red and gold and the word "SPORTS" is disclaimed.

[2] Reg. No. 2,207,589, issued on December 1, 1998, which sets forth a date of first use anywhere and in commerce of March 1998.

[3] Although Mr. Klaus represented the United States Patent and Trademark Office at the oral hearing, inasmuch as the Office actions and brief in support of the refusal to register were issued by Ms. Carruthers, she will be referred to as the "Examining Attorney" in this appeal.

likelihood of confusion. In re E. I. du Pont de Nemours & Co., 476 F.2d 1357, 177 USPQ 563, 568 (CCPA 1973). However, as indicated in Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976), in any likelihood of confusion analysis, two key considerations are the similarity of the goods and the similarity of the marks.[4]

Turning first, therefore, to consideration of the respective goods, it is well established, as pointed out by the Examining Attorney in her brief, that goods need not be identical or even competitive in nature in order to support a finding of likelihood of confusion. Instead, it is sufficient that the goods are related in some manner and/or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under situations that would give rise, because of the marks employed in connection therewith, to the mistaken belief that they originate from or are in some way associated with the same producer or provider. See, e.g., Monsanto Co. v. Enviro-Chem Corp., 199 USPQ 590, 595-96 (TTAB 1978) and In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

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[4] The court, in particular, pointed out that: "The fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks."

Here, while acknowledging in her brief that applicant's goods specifically exclude registrant's goods, the Examining Attorney, in support of her contention that applicant's various items of clothing, including footwear other than orthopedic, diving, and athletic shoes, are nonetheless so closely related to registrant's athletic shoes that, if marketed under the same or similar marks, confusion as to source or sponsorship would be likely, has made of record copies of 14 use-based third-party registrations which, in each instance, list athletic shoes in addition to a number of the same items of clothing as those set forth in applicant's application. While admittedly such registrations are not evidence that the different marks shown therein are in use or that the public is familiar with them, the registrations nevertheless have some probative value to the extent that they serve to suggest that the goods listed therein are of the kinds which may emanate from a single source. See, e.g., In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785-86 (TTAB 1993) and In re Mucky Duck Mustard Co. Inc., 6 USPQ2d 1467, 1470 (TTAB 1988) at n. 6. Moreover, the Examining Attorney has made of record three other use-based registrations, owned by the same entity as the owner of the cited registration for athletic shoes, which cover, although under different marks, some of the same articles of apparel as those for which applicant seeks to register his mark, namely,

jackets, shirts, shorts, sweatshirts, pants and caps. Such evidence is sufficient to establish that applicant's goods, while excluding athletic shoes, are still so closely related in a commercial sense to the latter that, if sold under the same or similar marks, confusion would be likely. The Board, in fact, has so found. See, e.g., In re Kangaroos U.S.A., 223 USPQ 1025, 1026 (TTAB 1984) [athletic shoes and men's shirts]. Applicant, we further observe, does not contend to the contrary in his brief, focusing instead on the differences in the marks at issue.

As to the respective marks, applicant argues that, when considered in their entireties, confusion is not likely. In particular, applicant contends that because he is also the owner of a registration for a mark which includes the name "DANIEL CREMIEUX" and golf player design,[5] his "common ownership" of such registration and "the present application, both of which contains [sic] his name, is to be taken into account when considering the scope to be given the mark here on appeal." In

[5] Reg. No. 1,440,968, issued on June 2, 1987, based upon ownership of French Reg. No. 1276042, dated July 16,1984; affidavit §8 accepted. Among the goods included in such registration are "sport jackets, skirts, shirts, pants, coats, raincoats, suits, jogging suits, sweaters, pullovers, dresses, sweat suits, shorts, footwear, lingerie, bathing suits, overalls, socks, [and] clothing belts." Curiously, while the copy of such registration made of record by the Examining Attorney includes the letters "DC" as part of the mark, the copy thereof furnished by applicant does not; however, the difference is immaterial for present purposes.

this regard, applicant contends with respect to the marks at issue herein that:

> When considering the marks in their entirety, it is clear that the only common feature is that both include the same letters "DCS" which in the registered mark are essentially meaningless while in applicant's mark ... these letters clearly relate not only to applicant's name but also to the type or style of his line of clothing. With such a plethora of differences between the respective marks, applicant respectfully submits that consumers purchasing applicant's goods would, without doubt, know that they were dealing with "Daniel Cremieux" ....

Furthermore, as to the Examining Attorney's position that the letters "DCS" clearly form the dominant part of applicant's mark, applicant maintains that (underlining and italics in original):

> [T]he Federal Circuit, in the case of In re Electrolyte Laboratories, Inc., [913 F.2d 930,] 16 USPQ2d 1239 [(Fed. Cir. 1990)], has cautioned that: "There is no general rule as to whether letters or design will dominate in composite marks .... No element of a mark is ignored simply because it is less dominant, or would not have trademark significance if used alone." Thus it is improper to ignore any of the different portions of applicant's composite mark.
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> Applicant's mark [consequently] must ... be considered in its entirety. It is manifestly improper to look merely at the letters "DCS" and ignore the remainder of the composite mark. That is not what the consuming public does. It is believed to be clear, and in accord with human nature, that

> upon noting applicant's mark (perhaps because of the colorful nature of the mark) attention *might* first be directed to the letters "DCS" but it is submitted that attention would immediately shift to the line of words reading "DANIEL CREMIEUX SPORT" so that the purchaser would certainly be aware of the source of the goods, without any mistake, confusion or deception.

We agree with the Examining Attorney, however, that contemporaneous use of the marks "DCS DANIEL CREMIEUX SPORT" and design and "DCS," in connection with, respectively, various items of clothing and athletic shoes, would be likely to cause confusion as to source or sponsorship. Applicant's contention that the presence of the wording "DANIEL CREMIEUX SPORT" in his mark serves to differentiate such mark from registrant's "DCS" mark, due in part to applicant's ownership of a registration for a mark which likewise includes the name "DANIEL CREMIEUX," is not persuasive since, as the Examining Attorney properly points out in her brief, "consumers who see applicant's pending mark will not necessarily be familiar with his registered mark." Moreover, even if applicant's name is regarded as his trade name or house mark, the Examining Attorney is also correct that "the addition of a trade name or house mark to one of two otherwise confusingly similar marks will not obviate [a] likelihood of confusion." See, e.g., In re Cosvetic Laboratories, Inc., 202 USPQ 842, 845 (TTAB 1979) and In re C. F. Hathaway Company, 190 USPQ 343, 344 (TTAB 1976).

We also concur with the Examining Attorney that, when considered in its entirety, applicant's "DCS DANIEL CREMIEUX" and design mark is dominated by the term "DCS." As the Examining Attorney accurately observes in her brief, "the display of applicant's mark unquestionably focuses the consumer's attention on the letters 'DCS,'" given their prominent size in relation to the much smaller wording "DANIEL CREMIEUX SPORT." While the latter gives meaning to the term "DCS" in applicant's mark, the absence thereof from registrant's mark, which contains only the arbitrary letters "DCS," does not mean that such letters are necessarily without significance. Instead, such letters could likewise be viewed by consumers, especially those familiar with applicant and his "DCS DANIEL CREMIEUX SPORT" and design mark, as an abbreviation or shorthand form of the words "DANIEL CREMIEUX SPORT," particularly when used in connection with such closely related items of apparel as athletic shoes. This is especially so, we note, inasmuch as registrant's mark, since it is registered in typed form, may be displayed in any reasonable format, including the same blue, white and red color combination as respectively appears in the letters "DCS" in applicant's mark. See, e.g., INB National Bank v. Metrohost Inc., 22 USPQ2d 1585, 1588 (TTAB 1992), citing Phillips Petroleum Co. v. C. J. Webb, Inc. 442 F.2d 1376, 170 USPQ 35, 36 (CCPA 1971). Thus, registrant's "DCS" mark must be

regarded as identical in sound, appearance and connotation to the dominant portion of applicant's mark, notwithstanding the presence in the latter of the wording "DANIEL CREMIEUX SPORT" and other design features which serve as a vehicle for the display of the literal terms in applicant's mark. Overall, applicant's "DCS DANIEL CREMIEUX SPORT" and design mark and registrant's "DCS" mark engender a substantially similar commercial impression.

Accordingly, we conclude that purchasers and potential customers, who are familiar or acquainted with registrant's "DCS" mark for its athletic shoes, would be likely to believe, upon encountering applicant's substantially similar "DCS DANIEL CREMIEUX SPORT" and design mark for its various items of clothing other than orthopedic, diving, and athletic shoes, that such closely related articles of apparel emanate from, or are sponsored by or associated with, the same source. Such consumers, in particular, would be likely to view applicant's "DCS DANIEL CREMIEUX SPORT" and design products as a new or expanded line of sportswear from the makers of registrant's "DCS" athletic shoes and vice versa.

Decision: The refusal under Section 2(d) is affirmed.